

Application No. 10/696,532  
Pre-Appeal Brief Request for Review

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**IN THE UNITED STATES PATENT  
AND TRADEMARK OFFICE**

Applicant(s): Naobumi OKADA

Serial No. : 10/696,532

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For : MICRODISSECTION APPARATUS  
AND METHOD

Art Unit : 1725

Examiner : Maria Alexandra Elve

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
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S I R :

Review of the Final Rejection in the above-identified application is respectfully requested. No amendments are being filed with this request, and this request is being timely filed with a Notice of Appeal.

The review is requested for the reasons set forth on the following five pages of explanation.

**R E M A R K S**

A Final Rejection was issued on December 13, 2006. This Pre-Appeal Brief Request for Review is being filed to request review of, in particular, the rejection under 35 USC 103 of independent claims 1, 12 and 23, on the grounds that the Examiner has clearly failed to establish a prima facie obviousness by failing even to mention in the Final Rejection at least two significant features of the claimed present invention, namely:

(i) an active optical element or pattern forming means, and

(ii) an objective lens that is positioned between the active optical element (pattern forming means) and the sample.

As set forth in MPEP 2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974), in order “[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.”

It is respectfully submitted that the Examiner has clearly failed to establish prima facie obviousness, and that there is a clear deficiency in the Examiner's rejection of independent claims 1, 12 and 23 (and the claims depending therefrom) under 35 USC 103. Accordingly, it is respectfully requested that this panel withdraw the rejections of claims 1-36.

More specifically, each of amended independent claims 1, 12 and 23 recites: (i) an active optical element (which may be transmissive or reflective within the scope of the claims) on

which a variable pattern is formed to correspond to a necessary area (claims 1 and 23), or pattern forming means for transmitting or reflecting the laser light selectively in accordance with a variable pattern which is set to correspond to a necessary area (claim 12), and (ii) an objective lens which is positioned between the active optical element or pattern forming means and the sample. According to the present invention as recited in independent claims 1, 12 and 23, laser light is irradiated through (transmitted through or reflected by) the active optical element or pattern forming means, and the laser light from the active optical element or pattern forming means is guided to the sample by the objective lens.

For an explanation of the operation of the active optical element (claims 1 and 23) or pattern forming means (claim 12) of the claimed present invention, the panel is referred to the Amendment filed on January 13, 2006, page 15, line 13 to the bottom of page 16. The panel is also referred to the active optical element 12 (as a liquid crystal substrate) in Figs. 1, 3 and 4 and active optical element 25 (as a reflection type active optical element such as a micro mirror array) in Figs. 5-7. One example of a pattern according to the present invention is shown in Fig. 2B.

With respect to the "active optical element" (claims 1 and 23) or "pattern forming means" (claim 12) recited in the

independent claims, the Final Rejection omits any reference to specific disclosure in the cited references that could be considered to correspond to an active optical element or pattern forming means, even though this deficiency in the Examiner's rejection has been repeatedly pointed out. See the Amendment filed on August 3, 2005, page 25, lines 21-24; the Amendment filed on January 13, 2006, page 15, lines 9-12; the Amendment filed on March 20, 2006, page 17, lines 4-12 (referring to specific embodiments of active optical elements recited in dependent claims); and the Amendment filed on September 27, 2006, page 17, lines 1-3. Indeed, despite these repeated requests for the Examiner to provide support for her assertions that the cited references disclose an active optical element or pattern forming means, the Final Rejection does not even mention an active optical element or pattern forming means.

The clearest indication of the Examiner's position is set forth in the Continuation Sheet of the Advisory Action mailed on February 16, 2006, in which the Examiner refers to Figs. 1 and 5 of USP 6,251,516 ("Bonner et al") as disclosing an active optical element. It is respectfully submitted, however, that even this brief statement by the Examiner omits any reference to any specific structure in Bonner et al that could be considered to correspond to an active optical element. For a more detailed explanation of the failure of Figs. 1 and 5 of Bonner et al to

disclose an active optical element or pattern forming means, see the Amendment filed on March 20, 2006, page 16, line 5 to page 17, line 3.

In the absence of any specific explanation by the Examiner, the applicant has attempted, in the various responses to Office Actions, to determine what feature of Bonner et al the Examiner considers to correspond to the active optical element. At best, it would appear that transfer film 54 of Bonner et al is the only element of Bonner et al on which a pattern might be considered to be formed and through which light is irradiated. It should be understood, however, that the transfer film 54 is not an "active" optical element as recited in claims 1 and 23 and clearly does not transmit or reflect light selectively in accordance with a variable pattern in the manner of the pattern forming means recited in independent claim 12. See, for example, page 17 of the Amendment filed on January 13, 2006, for a discussion of the transfer film 54 of Bonner et al.

Significantly, in order to function, the transfer film 54 of Bonner et al must contact the sample. See the Amendment filed on March 20, 2006, page 18, lines 4-14.

In order to even more clearly distinguish over Bonner et al (or, to distinguish over the applicant's assumption as to how the Examiner is interpreting Bonner et al), each of independent claims 1, 12 and 23 recite an objective lens that is positioned

between the active optical element (or the pattern forming means) and the sample. Since the transfer film 54 of Bonner et al must contact the sample to function, clearly Bonner et al cannot logically be modified to provide an objective lens between the transfer film 54 of Bonner et al and the sample. See the Amendment filed on September 27, 2006, page 17, line 4 to page 18, line 9.

In response to these recitations of the independent claims, the Examiner merely asserts that Bonner et al discloses that "microscopic objectives are used" and that USP 6,870,625 ("Baer et al") discloses that an "entire tissue sample or specific parts of it can be selectively excited by selecting different lenses of one or more objectives from an objective wheel turret." Thus, the Examiner makes no mention of the positioning of the objective lens according to the present invention, and the Examiner gives no indication as to how Bonner et al could be modified to provide an objective lens between the active optical element (or the pattern forming means) and the sample in the manner of the claimed present invention.

In view of the foregoing, it is respectfully submitted that the Examiner has clearly failed to establish a case of *prima facie* obviousness of independent claims 1, 12 and 23 (and the claims depending therefrom) by failing even to mention in the Final Rejection: (i) the active optical element recited in

independent claims 1 and 23 and the pattern forming means recited in independent claim 12, and (ii) an objective lens that is positioned between the active optical element (pattern forming means) and the sample. And it is respectfully submitted that this combination of features of the claimed present invention is clearly not at all disclosed, taught or suggested by the cited references, taken singly or in combination, under 35 USC 103.

It is also noted that the Examiner has raised various issues of intended use and method of use of an apparatus in the Final Rejection. It is respectfully submitted, however, that the above described deficiencies in the Examiner's rejection of claims 1, 12 and 23 relate to structural features of the present invention. In addition, the issues raised by the Examiner with respect to intended use and method of use of an apparatus clearly do not apply to method claim 23 or to the claims depending therefrom.

In view of the foregoing, it is respectfully requested that the Pre-Appeal Brief Conference Panel withdraw the rejection of claims 1-36.

Respectfully submitted,

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